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72

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,545

10/23/2003

Egill Sveinbjorn Egilsson

EGIL3002 /JEK/ JJC

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05/18/2004

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EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,545

Applicant(s)

EGILSSON, EGILL SVEINBJORN

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 23, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4-6, 9-11, 14, 18 and 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 8, 12, 13, 15-17, 19-24 and 27-32 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3738

Claims 2, 4-6, 9-11, 14, 18, and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse.

The disclosure is objected to because of the following informalities: On page 2, line 15, "amputee" is misspelled. On page 8, line 20, "went" should apparently be omitted. On page 8, last line, "on" should apparently be --or--. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Haberman, US 5,888,216. The prosthesis liner being of silicone (e.g., column 8, lines 3-6) is inherently radially elastically extendible from a relaxed non-extended condition. At least one radially protruding seal element lies between proximal and distal end areas (column 3, lines 34-37 and 51-58; column 6, lines 52-54) of a generally conical (column 2, lines 48-49; column 6, lines 30-31) body portion. Regarding claim 30, the recessed portion is that portion between two of the plurality of thickened bands (e.g., Figure 8).

Art Unit: 3738

Claims 1 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haberman, US 5,888,216. A less "bent" conical shape was well known in the art at the time of the present invention and would have been an obvious step backward in view of column 2, line 66, through column 3, line 16, so as to simplify manufacture of the device.

Claims 1, 12, 13, 19, 20, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blatchford et al., GB 267,988.

Claims 3, 15, 22-24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatchford et al., GB 267,988. The "annular projections" (page 1, line 30) being separately formed and adhesively secured into recesses of the "extensible inner sack" (page 1, line 26) would have been obvious, if not inherent, from the expressions "fitted or formed" (e.g., page 1, line 31) and "disposed within" (e.g., page 2, lines 110-111) in order to provide different or modified materials for the respective functions of the annular projections and the remainder of the extensible sack. Under an alternative interpretation, annular projections (page 1, lines 63-64) of the *outer socket* (which can be made of "india-rubber": page 1, line 51) engage annular grooves of the inner extensible sack (page 1, lines 83-91) and are thus attached or secured to said grooves during use. The further limitations of claim 27 would have been met under the first interpretation because of the tapering or roundedness of the illustrated projections *b*.

Claims 7, 8, 16, 17, 21, 28, 29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatchford et al., GB 267,988, in view of Fay, US 6,231,617 B1. Substantially non-stretchable, elongate arms being embedded in the extensible inner sack of Blatchford et al. in the manner prescribed by Fay would have been an obvious upgrade in order to "inhibit milking of a residuum" (Fay: abstract, line 6), with the ordinary practitioner having been

Art Unit: 3738

motivated by Fay's comments at column 8, lines 53-65, in conjunction with the fact that the Blatchford et al. inner sack is specifically designed to support the weight of the prosthesis during the swing phase of the gait.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 6,508,842 B1: Figure 18; column 14, lines 1-10.

WO 00/74611 A2: Figure 17; page 11, lines 4-9; page 20, lines 18-22.

Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
Art Unit 3738